UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/872,239	MINEYAMA, TORU
	Examiner	Art Unit	
	Farzana E. Hossain	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *01 June 2001*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-253* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *70-253* is/are allowed.

6) ☒ Claim(s) *1-20, 24-35, 39-50, 54-65, 69* is/are rejected.

7) ☒ Claim(s) *21-23, 36-38, 51-53 and 66-68* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *01 June 2001* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 28 is objected to because of the following informalities: Claim indicates

depending from Claim 23, however, the Office assumes Claim 28 depends from Claim

25. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-20, 24-35, 39-50, 54-65, 69 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Ellis et al (US 2005/0028208 and hereafter referred to as

"Ellis") in view of Daniels (US 2002/0032907). Also note Knudson, which is

incorporated by reference into Ellis.   It is noted that Ellis incorporates by reference in its

entirety the application Knudson et al (Application No. 09/330,792 and published for

continued application 10/929,111 (US 2005/0204388) and hereafter referred to as

"Knudson").

Regarding Claims 1 and 5, Ellis discloses a program information providing

apparatus and method (Figures 2b, 2d, 6a, and 6b, 16) having storage means for

storing program information (Figure 2d, 25), which is attribute information about a

program, and a program chart (Page 5, paragraph 0072), the program information and

the program chart being sent to a first terminal apparatus (Figures 2b, 2d, 6a, and 6b,

16 and Figure 5) in response to a request from the first terminal apparatus for sending

the program information (Page 5, paragraphs 0072, 0073, 0074) and the program chart

via a network (Figure 2b, Figure 2d), the program information providing apparatus

comprising: a processing means to process a request (Page 5, paragraph 0075 – see

Knudson disclosure below) for recording or update to the program guide settings

(Abstract, Page 2, paragraph 0019 from the first terminal apparatus to which the

program chart has been sent (Figures 2b, 2d, 6a, 6b). Ellis discloses a program

recording preset script, which is a control command (Page 5, paragraph 0075, Page 9,

paragraph 0104) for controlling a recording apparatus (Figure 3, 32) to record a

specified program listed in the program chart to a recording medium (Figure 3, 32, Page

11, paragraph 0127, Page 15, paragraph 0163). The program guide server forwards

commands after processing a recording request from the first terminal (Figure 2d), that

the server has program recording commands and generating means for generating, on

the basis of the program information retrieved by the searching means or processing

means. Ellis discloses a sending means for sending the program recording preset

script generated by the program recording preset commands to a second terminal

apparatus (Figure 2d, Page 5, paragraph 0075, Page 9, paragraph 0104). Knduson

discloses a searching means for searching the storage means for the program

information in response to a program recording preset request or update to program

guide settings which includes recording (Page 8, paragraph 0087).

Regarding Claims 1, 5, 9, 25, 40, 55 all the limitations of the claims are listed in

the rejection of Claims 1 and 5 respectively except for the following limitations. Ellis

discloses a program preset system and method comprising a first terminal apparatus

(Figures 2b, 2d, 5, 6a and 6b, 24), a program information providing apparatus (Figures

2b, 2d, 6a and 6b, 17, 16, 25), and a second terminal apparatus (Figures 2b, 2d, 3, 6a,

6b, 17, 22) are interconnected via a network (Figures 2b, 2d, 6a, 6b, 19), the first

terminal apparatus includes a display means (Page 7, paragraph 0092) for displaying

received program information and program chart (Page 5, paragraph 0072), input

means (Page 7, paragraph 0092) for inputting a program recording preset request

(Page 2, paragraph 0015, Page 11, paragraph 0127), first sending means for sending

the program recording preset request inputted through the input means (Page 5,

paragraph 0075). The program information providing apparatus or server has a

receiving means, as it handles all incoming (or received) requests (including a program

recording preset request) made by the remote access device (Page 5, paragraph 0075,

Page 11, paragraph 0127). It is also included that the server comprises a (second)

sending means for sending the program information retrieved by the searching means

to the first terminal apparatus or that program information accessed and searched by

the user is displayed (Page 5, paragraph 0072); and third sending means for sending

the program recording preset script generated by the program recording preset script

generating means (Page 5, paragraph 0075). It is necessarily included that the server

has sending means as it updates the second terminal device with all changes to the

program guide settings, which includes commands for recordings made by a request of

the first terminal device.

Ellis is silent on the script generating means of the program providing apparatus

or server and the second terminal apparatus including: second receiving means for

receiving the program recording preset script supplied from the third sending

means of the program information providing apparatus as the client-server

communications (Page 9, paragraph 0104) sends commands to record to the second

terminal device. Daniels discloses a server with a program recording control command

generating means (Figure 7) and a second receiving means for receiving the program

recording preset script (Figure 7, 2, Figure 8, 4, Figure 10) supplied from the third

sending means of the program information providing apparatus (Figures 7, 8, 9); and

signal converting means for converting the program recording preset script received by

the second receiving means into a program recording preset control signal (Page 13,

paragraph 0132, Figure 7, Figure 14). Since applicant's disclosure describes the script

as an executable function, both Ellis and Daniels, while not using the term script, both

execute recording as control signals without interaction, thus being considered script or

software, which automatically executes. Therefore, it would have been obvious at the

time the invention was made to one of ordinary skill in the art to modify Ellis to indicate

that commands or the program recording preset control signal generated by the server

are sent to the second terminal device and then converted to a control signal (Figure 7, 2, Figure 8, 4, Figures 9-14) as taught by Daniels in order to provide a less complicated way of programming the VCR including cable and television media by using an Internet program guide (Page 3, paragraphs 0023, 0024).

Regarding Claims 40, 55, all the limitations of the claims are listed in the rejection of Claims 1,5, 9 and 25 except for the following limitations. Ellis discloses receiving the program from the program guide (Figure 1) in order to record the program (Page 11, paragraph 0127). Knudson discloses that the second terminal will send the control signals to the recording medium (Page 8, paragraph 0087). The recorder has control means to record the program on the recorder. Daniels discloses that the recording apparatus includes a receiving means to receive the converted control signal from the second terminal (Figures 7-14). Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Ellis to convert the command or script to a control signal (Figure 7, 2, Figure 8, 4, Figures 9-14) as taught by Daniels in order to provide a less complicated way of programming the VCR including cable and television media by using an Internet program guide (Page 3, paragraphs 0023, 0024).

As for claims 2, 6, 13, 28, 41, 56, Ellis discloses that (Figure 3, 31, 32) where recoding can be done in different storage device and that program guide settings can be changed as requested (Page 5, paragraph 0075) which includes recorders.

As for claims 3, 7, 14-20, 29-35, 42-50, 57-65, Knudson provides a cancel function, which is automatic thus being considered script (Figure 11, 148). Ellis

discloses that all functions can be done at the remote device or user device in a peer-to-peer or client server communications (Page 9).

As for claims 4, 8, Knudson discloses the required canceling script comes from a user interface on the first terminal (see figure 11) and Ellis notes that any peer to peer or client to server communications are possible (Page 9, paragraph 0104).

As for claims 10, 26, Ellis discloses receiving the program listings and program (Figure 1).

As for claim 11, Ellis shows at least one recording medium (Figure 3, 31, 32).

As for claim 12, Daniels discloses the second terminal controlling the recording on the recording medium (Figures 7-14).

As for claims 24, 39, 54, 69, Ellis discloses that pay program account information, which can include charging for recording service (Pages 4-5, paragraph 0070).

As for claim 27, Ellis discloses that the second terminal records the received program in accordance to the control signal (Figure 3, 31, 32).

Allowable Subject Matter

4.   Claim 21-23, 36-38, 51-53, 66-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5.   Claims 70-253 are allowed.

6.   The following is a statement of reasons for the indication of allowable subject

matter for claims 21-23, 36-38, 51-53, 66-68, 70-253:

Ellis discloses a system and method comprising a first terminal apparatus

(Figures 2b, 2d, 5, 6a and 6b, 24), a program information providing apparatus (Figures

2b, 2d, 6a and 6b, 17, 16, 25), and a second terminal apparatus (Figures 2b, 2d, 3, 6a,

6b, 17, 22) are interconnected via a network (Figures 2b, 2d, 6a, 6b, 19), and a second

terminal apparatus with a recording medium (Figure 3, 31, 32).   Daniels discloses a

system and method of the server generating a script and sending the script to the

second terminal apparatus (Figures 7-9).   The system and method are described in

further detail in the above rejections.

Tso et al (US 6,047,327 and hereafter referred to as "Tso") discloses a system

with content providers and servers providing information via an email message to clients

or users (Figure 1). Tso discloses that the server to comprise an electronic mail (email)

generating means for generating a message (Column 10, lines 27-30) with information

attached with a plurality of program information items in the storage (Column 10, lines

30-31), address generating and attaching means for generating an address to be linked

with any of the items and attaching the address to the email (Column 1, lines 44-50,

Column 8, lines 48-64), the sending means to send the email message with the

attachment (Figure 5, 103).

The prior art of record does not teach or suggest "electronic mail generating

means for generating an email indicating the reception of program recording preset

script" **or** "address generating and attaching means for generating a program recording

preset address to be linked with any one of said plurality of items of program information

stored in said first storage means and attaching the generated program recording preset

address to the program introducing electronic mail message generated by said

electronic mail generating means for each item of the program introducing information"

or "generating a program recording preset address to be linked with any one of the

stored plurality of items of program information, attaching the generated program

recording preset address to the generated program introducing electronic mail message

for each item of the program introducing information."

Any comments considered necessary by applicant must be submitted no later

than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on

Statement of Reasons for Allowance."

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Franco (US 2002/0046407) allows the user to remotely program

its video recording device via a website. The website allows the user to use a web page

with program gird that lists programs receivable by the user's video record system and

allows the user to click on a program so that it can be recorded (Pages 5-6, paragraph

0069).

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Farzana E. Hossain whose telephone number is 571-

272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to

4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

FEH
September 29, 2005

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